

Attorney Docket No. 17600-55098



IPW/AF
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of: Wiggins, J.

Appl. No.: 10/828,645

Group Art Unit: 3722

Filed: 04/21/2004

Examiner: Carter, M.

For: Index Tab Labeling System for Hanging File Folder

**Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION-37 CFR 1.192)**

1. Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal mailed July 18, 2005.
2. A Statement Claiming Small Entity Status has previously been filed.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on _____

Sept. 1, 2005

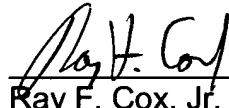
Ray F. Cox, Jr.

Ray F. Cox, Jr.

3. The fee for filing the Appeal Brief for a small entity is \$250.00.
4. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.
5. The total fee due is \$250.00. Attached is a check in the sum of \$250.00.
6. If any additional extension or fee is required, charge Account No. 23-3263. Please refund any overpayment. A duplicate of this document is attached.
7. Also enclosed is a self-addressed, stamped postcard.

Respectfully submitted,

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APPELLANT'S BRIEF (37 C.F.R. §1.192)

This brief is in furtherance of the Notice of Appeal in this case mailed on July 18, 2005. The fees required and any required petition for extension of time for filing this appeal brief are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

<p style="text-align: center;"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450</p> <p>on <u>Sept. 1, 2005</u></p> <p><u>Ray F. Cox, Jr.</u> Ray F. Cox, Jr.</p>
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This brief contains these items under the following headings and in the order set forth below (37 C.F.R. §1.192(c)):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT

A. Claims 1-7 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Snowden (U.S. Patent No. 4,053,057) in view of Berman (U.S. Patent No. 5,641,550).

1. Snowden is not properly combined with Berman since there is no teaching, suggestion or motivation for making the combination.

2. The prior art cited by the examiner provides no indication that the problem identified by the present invention has been recognized by either Snowden or Berman.

3. Berman is not analogous art that the inventor would have been expected to examine to discover the answer to the problem he had identified.

4. Applying the notepad of Berman to the index tab of Snowden would produce an unworkable combination.

B. Conclusion

VIII. CLAIMS APPENDIX

IX. EVIDENCE APPENDIX

X. RELATED PROCEEDINGS APPENDIX

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Joey Martin Wiggins, the applicant.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals and interferences that may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences.

III. STATUS OF CLAIMS

The status of the claims in this application is as follows:

No claims are allowed.

No claims are objected to.

No claims are withdrawn.

Claims 1-7 are pending and stand finally rejected.

Claims 1-7 are appealed.

IV. STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The independent claims involved in the appeal are claims 1, 5 and 7.

Claim 1 is directed to an index tab labeling system for a suspended file folder 10 of the type having spaced vertical slots 11 along an upper margin 12. Such a suspended file folder 10 as known in the prior art is shown in Fig. 1 and described in paragraph [0015]. The index tab labeling system comprises at least one flexible index tab 20 with flexible lugs 21 for insertion into the spaced vertical slots 11 of the suspended file folder 10 and at least one pad 30 with a plurality of labels 31.

Paragraphs [0015] and [0016]. Each label 31 is a sheet with an upper surface 32 for entering information and a lower surface 33 coated with a releasable adhesive 34.

Paragraph [0016]. The index tab 20 has a space 22 for receiving the pad 30 of labels 31. Paragraph [0015].

Claim 5 is directed to the same subject matter as claim 1 with the additional limitations that the flexible index tab 20 comprises a single sheet of flexible material (paragraph [0015]) and the pad 30 comprises at least three labels 31 (paragraph [0017]).

Claim 7, likewise, is directed to the same subject matter as claim 5 with the additional limitation that the lower surfaces 33 of each of the labels 31, 41 has an adhesive portion 42 and a non-adhesive portion 43. Figs. 4A and 4B, paragraph [0019].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Are claims 1-7 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Snowden (U.S. Patent No. 4,053,057) in view of Berman (U.S. Patent No. 5,641,550)?

VII. ARGUMENT

Claims 1-7

A. Claims 1-7 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Snowden (U.S. Patent No. 4,053,057) in view of Berman (U.S. Patent No. 5,641,550).

The examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Snowden in view of Berman. In particular, the examiner stated that Snowden discloses suspended filing folders comprising at least one flexible index tab (20) having flexible lugs (18) for insertion into spaced vertical slots (17), the flexible index tab having a space for receiving a label as seen in Fig. 4 of Snowden. The examiner concludes that Snowden discloses the claimed invention except for providing at least one pad comprising a plurality of labels in the space of the index tab. In this regard, the examiner states that Berman discloses a note pad (10) comprising a plurality of labels (12, 14, 16), each of the labels comprising a sheet having an upper surface for entering information (referencing col. 3, lines 44-49 of Berman) and a lower surface coated with a releasable adhesive (18) (referencing Fig. 1 of Berman). The examiner concludes that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Snowden's invention by replacing the label of

Snowden with a notepad having a plurality of labels, as taught by Berman, to provide an indexing system with a plurality of labels for including additional information in the index tab.

1. Snowden is not properly combined with Berman since there is no teaching, suggestion or motivation for making the combination.

The examiner characterizes the notepad taught by Berman et al. as comprising a plurality of "labels." However, Berman does not use this term (referring instead to "sheets") and does not teach any specific use of his notepad for any purpose other than taking notes. In particular, Berman does not teach attaching the notepad to an index label or in any way suggest the desirability of doing so. While Berman teaches applying the notepad to various work surfaces, the specific examples (table, desk, refrigerator, doorway) are not such as to suggest the use of the notepad in conjunction with an index tab. In fact, the enumerated work surface examples suggest the use of the notepad for taking notes and do not suggest any other purpose.

The examiner asserts that the term "label" means "an item that functions as a means of identification, especially a small piece of paper or cloth attached to an article to designate its origin, contents, use or destination." (Citing the American Heritage® Dictionary of the English Language). The examiner then asserts that the sheets of Berman function as a means of identification, since the intent of the invention is to receive indicia. However, in attempting to justify inserting the term "label" in place of the term Berman actually uses, i.e., "sheets," the examiner again attempts to substitute a term ("indicia") that Berman does not use. Berman refers to placing a "readable symbol" on a sheet of the article. The term "readable symbol" does not equate to, and

does not suggest, "indicia" or "means of identification." In context, Berman uses the term "readable symbol" at col. 3, lines 35-36, within a paragraph that begins "A method of taking notes according to the instant invention can be carried out as follows." Col. 3, lines 30-31. There is therefore no suggestion that Berman intends or teaches that the "readable symbol" is a means of identification, rather Berman consistently refers to the term "readable symbol" only in the context of taking notes.

The examiner argues that Berman's pad of paper sheets has the same structure as in the claimed invention. Apparently, the examiner is comparing Berman with a portion of the claimed invention, namely the pad of labels, considered in isolation from the entirety of the claimed invention. But that is not the issue, the issue is whether Snowden and Berman in combination suggest the entirety of the claimed invention.

In this regard, the examiner argues that Berman discloses a pad of sheets of paper labels for receiving identifying information. See the Office Action of 4/27/05, page 5, first paragraph. However, here again the examiner treats Berman as disclosing something that Berman does not disclose. Berman nowhere suggests that his "sheets of paper" are "labels for receiving identifying information." The examiner simply assumes a teaching that does not appear in Berman.

In summary, the examiner has not identified any teaching in the prior art to suggest the desirability of combining the notepad of Berman with an index tab. Neither Snowden nor Berman provide such a motivation.

2. The prior art cited by the examiner provides no indication that the problem identified by the present invention has been recognized by either Snowden or Berman.

Berman simply does not address the subject of index tabs at all. Snowden, while teaching an index tab, discloses no perceived need to employ labels that can be adhered to the outer surface of the index tab or to allow used labels to be easily removed by peeling the topmost used label from a pad of labels adhered to the index tab. Snowden does not suggest using the space on the exterior of the index tab for a label. Such would be contrary to Snowden's teaching that the label is inserted into the space between the front and back portions of the index tab.

The examiner argues that the applicant has simply recognized an advantage that naturally flows from the suggestions of the prior art and that such cannot be the basis for patentability. However, as the applicant has argued above, the prior art does not suggest the claimed combination. Therefore, the advantage identified by the applicant does not flow naturally from the teachings of the prior art.

3. Berman is not analogous art that the inventor would have been expected to examine to discover the answer to the problem he had identified.

The problem identified as requiring solution in the present invention (see generally paragraph [0004] of the specification) is the inconvenience of the prior art type of labelling system where the labels must be inserted into the space between the front and back portions of the index tab. When labels require changing to reflect the changing contents of the file folder or to allow the folder to be reused for a different purpose, the old label must be removed from the index tab, which may require removing the index tab from the folder before the new label can be inserted and then reinstalling

an index tab in the file folder. In addition, the prior art system also suffers from a tendency for the labels to fall out of the index tab and become lost. It is clear from simply stating the problem that a person of ordinary skill in the art is not led to search in the field of notepads to find an answer. Without knowing *a priori* the answer conceived of by the inventor, one would have no reason to consider the field exemplified by Berman. Berman is therefore not analogous to the problem faced by the inventor and cannot be used to suggest that the invention is obvious with respect to such art.

The examiner's response to this argument is simply to repeat the incorrect assertions that the readable symbols on the sheets of "Berman et al. function as a means of identification, since the intent of the invention is to receive indicia." Office Action, 4/27/05, page 5, lines 18-19. As applicant has pointed out above, Berman does not teach that the readable symbols are means of identification or that the intent of the invention is to receive indicia. By simply repeating these incorrect assertions, the examiner has not shown any pertinence of Berman to the problem faced by applicant.

4. Applying the notepad of Berman to the index tab of Snowden would produce an unworkable combination.

As shown in Fig. 3, the label 32 of Snowden is taught as being inserted into the tab rather than affixed to the surface of the tab. Inserting the notepad of Berman inside the index tab as taught by Snowden would defeat the purpose of having a plurality of sheets. Therefore, the teachings of Snowden and Berman would produce an unworkable combination. It is therefore, also improper for this reason to combine Snowden and Berman.

B. Conclusion

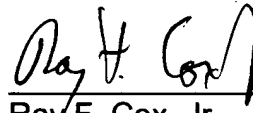
In summary, the prior art cited by the examiner provides no motivation to combine the references as suggested by the examiner, the prior art cited by the examiner shows no indication that the problem solved by the present invention was recognized in the prior art, the art cited by the examiner (Berman) is not analogous to the problem faced by the inventor and the combination of the teachings of the cited references would produce an unworkable combination. Combining Snowden and Berman is therefore improper and may not be the basis for a prima facie case of obviousness. Therefore, it is respectfully submitted that the claimed invention cannot be considered obvious with respect to the cited references.

It is therefore submitted that the examiner erred in finding that claims 1-7 are obvious due to the combination of Snowden and Berman. It is clear from the above that the features of the presently claimed invention provide meaningful and clear-cut distinctions over the references of record and therefore all claims should be allowable. It is also clear that the applicant's invention is new and useful, that the differences over the closest and most pertinent prior art are material and significant, and that there is no basis in law for the rejections set forth by the examiner. Since the claims have specific limitations not considered by the examiner and not or disclosed or made obvious by the prior art, the claims should be allowable.

Accordingly, for the reasons cited above, it is respectfully requested that the Board of Patent Appeals and Interferences correct the above errors by reversing the final rejection and directing allowance of claims 1-7.

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VIII. CLAIMS APPENDIX

1 (original). An index tab labeling system for a suspended file folder of the type having spaced vertical slots along an upper margin, comprising:

at least one flexible index tab having flexible lugs for insertion into the spaced vertical slots; and

at least one pad comprising a plurality of labels, each of said labels comprising a sheet having an upper surface for entering information and a lower surface coated with a releasable adhesive, said flexible index tab having a space for receiving said pad.

2 (original). The index tab labeling system of claim 1 wherein said pad comprises at least three labels.

3 (original). The index tab labeling system of claim 1 wherein said lower surfaces of said labels comprise a non-adhesive portion.

4 (original). The index tab labeling system of claim 1 wherein said flexible index tab comprises a single sheet of flexible material.

5 (original). An index tab labeling system for a suspended file folder of the type having spaced vertical slots along an upper margin, comprising:

at least one flexible index tab comprising a single sheet of flexible material having flexible lugs for insertion into the spaced vertical slots; and

at least one pad comprising at least three labels, each of said labels comprising a sheet having an upper surface for entering information and a lower surface coated with a releasable adhesive, said flexible index tab having a space for receiving said pad.

6 (original). The index tab labeling system of claim 5 wherein said lower surfaces of said labels comprise a non-adhesive portion.

7 (original). An index tab labeling system for a suspended file folder of the type having spaced vertical slots along an upper margin, comprising:

at least one flexible index tab comprising a single sheet of flexible material having flexible lugs for insertion into the spaced vertical slots; and

at least one pad comprising at least three labels, each of said labels comprising a sheet having an upper surface for entering information and a lower surface comprising a first portion coated with a releasable adhesive and a second non-adhesive portion, said flexible index tab having a space for receiving said pad.

IX. EVIDENCE APPENDIX

Not Applicable.

X. RELATED PROCEEDINGS APPENDIX

Not Applicable.